

**REMARKS**

Claims 1 and 20 have been amended by incorporating the subject matter of Claims 10 and 11, and the claims further amended by adding new limitations for the material forming the light-transmitting region. Claims 10-12 have been canceled. Support for the amendments to Claims 1 and 20 is presented, for example, in Claims 10 and 11 as filed previously and in the specification at page 22, lines 20-25. Thus, no new matter has been added. Applicant respectfully requests entry of the amendments and reconsideration of the present application in view of the amendments and the remarks set forth below.

**Discussion of Claim Rejections Under 35 U.S.C. § 102(b)**

Claims 1-4, 7, 10, 12, 13, 15, and 20 have been rejected under 35 U.S.C. § 102(b), as being anticipated by Ishikawa et al (U.S. Publication No. 2002/0,042,243). Applicants respectfully submit that pending claims are allowable over Ishikawa, as discussed below.

**Discussion of Patentability of Independent Claims 1 and 20**

As amended herein, the subject matter of Claim 11, which has not been rejected on this ground, has been incorporated into Claims 1, and 20. Therefore, Claims 1, and 20 should not be rejected on this ground either. Applicant respectfully request withdrawal of the rejections.

**Discussion of Patentability of Dependent Claims**

The rest of the rejected claims depend from Claim 1 directly or indirectly, and further define additional technical features of the present invention. In view of the patentability of Claim 1, and in further view of the additional technical features, Applicant respectfully submits that the dependent claims are patentable over the prior art.

**Discussion of the Claim Rejections Under 35 U.S.C. § 103**

Claims 1, 7, 10, 13, 15, 18, 19, and 21 have been rejected under 35 U.S.C. § 103 as being unpatentable over Takashi et al. (JP. 11-07517) in view of Halley (US Patent No. 6,361,647). Applicants respectfully submit that Claims 1, 7, 10, 13, 15, 18, 19, and 21 are allowable over the cited references, as discussed below.

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**Filing Date: May 26, 2005**

#### Discussion of Patentability of Independent Claim 1

As amended herein, the subject matter of Claim 11, which has not been rejected on this ground, has been incorporated into Claim 1. Therefore, Claim 1 should not be rejected on this ground either. Applicant respectfully requests withdrawal of the rejection.

#### Discussion of Patentability of Dependent Claims

The rest of the rejected claims depend from Claim 1 directly or indirectly, and further define additional technical features of the present invention. In view of the patentability of Claim 1, and in further view of the additional technical features, Applicant respectfully submits that the dependent claims are patentable over the prior art.

#### Discussion of the Claim Rejections Under 35 U.S.C. § 103

Claims 1, 4, and 7 have been rejected under 35 U.S.C. § 103 as being unpatentable over Hasegawa Toru (JP. 2002/324,770) in view of Halley (US Patent No. 6,361,647). Applicants respectfully submit that Claims 1, 4, and 7 are allowable over the same reason presented above. Applicant respectfully requests withdrawal of the rejection.

#### Discussion of the Claim Rejections Under 35 U.S.C. § 103

Claims 14, 16, and 17 have been rejected under 35 U.S.C. § 103 as being unpatentable over Hasegawa Toru (JP. 2002/324,770) in view of Halley (US Patent No. 6,361,647) and in further view of Kouchiyu et al. (JP 2001/261,874). Applicant respectfully submits that Claims 14, 16, and 17 are allowable over the cited references, as discussed below.

#### Discussion of Patentability of Claims 14, 16 and 17

Claims 14, 16, and 17 depend directly or indirectly from Claim 1. As amended herein, Claim 1 recites, among other things “the polyurethane resin as the material for forming the light-transmitting region are different materials but produced from the same kinds of organic isocyanate, polyol and chain extender” and “the polyurethane resin as the material for forming the light-transmitting region does not contain aromatic polyamine and the material for forming

the light transmitting region is non-foam”, while the cited references describe polishing pad without the light transmitting region (Kouchiyu et al. and Halley) or a thickness of the light transmitting region is thinner (Hasegawa Toru).

Thus, the combination of cited references fails to teach those specific features of the subject matter in Claim 1. Accordingly, the cited references would not match with the present claimed invention, even if combined, and will not lead to a prima facie showing of obviousness, and Claims.

In addition to the above, Claim 1 as amended herein recites “An apparatus for chemical mechanical polishing of material to be polished **in conjunction with the material to be polished**” to clarify the material to be polished is an expressed part of the body of the claims and further recites a length (D) in a diametrical direction is 1/4 to 1/2 relative to the diameter of a material to be polished” The cited references do not disclose the ratio of length D to the diameter of the material to be polished, and Table 3 of the present specification shows that ratios below the claimed range performed poorly compared to those within the claimed range. In addition, the previously submitted Declaration under 37 C.F.R. § 1.132, shows a poor Polishing Rate with the ratio of 6.8, well above the claimed range. Thus, the data in Table-3 in the specification and in the Declaration show the criticality of the range. Moreover, the specification state that “when the length D is greater than 1/2, the polishing region is decreased, and thus the efficiency of polishing tends to be lowered.” (Page 13, lines 17-19). Nothing in the prior art would lead one having ordinary skill in the art to expect these results. Therefore, even if prima facie case of obviousness were established, this unexpected result would rebut any such case.

Thus, Claim 1 is patentable over the cited references and Claims 14, 16, and 17 are patentable for the same reasons with respect to Claim 1. Applicant respectfully requests withdrawal of the rejection.

#### **Discussion of the Claim Rejections Under 35 U.S.C. § 103**

Claims 2 - 4, 12, and 20 have been rejected under 35 U.S.C. § 103 as being unpatentable over Takashi et al. (JP. 11-07517) or Hasegawa Toru (JP. 2002/324,770) in view of Halley (US Patent No. 6,361,647) Applicants respectfully submit that Claims 2 - 4, 12, and 20 are allowable over the cited references, as discussed below.

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Discussion of Patentability of Claims 2-4, 12, and 20

Claims 2-4 depend from Claim 1. Claim 12 has been canceled. As amended herein, the subject matter of Claim 11, which has not been rejected on this ground, has been incorporated into Claims 1, and 20. Therefore, Claims 1 and 20 should not be rejected on this ground either. Claims 2-4 depend from Claim 1, and further define additional technical features of the present invention. In view of the patentability of Claim 1 and in further view of the additional technical features, these are patentable over the cited references. Applicant respectfully requests withdrawal of the rejection.

**Discussion of the Claim Rejections Under 35 U.S.C. § 103**

Claims 14, 16-19, and 21 have been rejected under 35 U.S.C. § 103 as being unpatentable over Ishikawa et al (U.S. Publication No. 2002/0,042,243) in view of Kouchiyu et al. (JP 2001/261,874) Applicants respectfully submit that Claims 14, 16-19, and 21 are allowable over the cited references, as discussed below.

Discussion of Patentability of Claims 14, 16-19, and 21

Claims 14, 16-19, and 21 directly or indirectly depend from Claim 1. As discussed above, Claim 1 has been amended by incorporating the subject matter of Claim 11, which has not been rejected on this ground. , Claims 1 and 20 should not be rejected on this ground either. The rejected claims depend from Claim 1, and further define additional technical features of the present invention. In view of the patentability of Claim 1 and in further view of the additional technical features, these are patentable over the cited references. Applicant respectfully requests withdrawal of the rejection.

**Discussion of the Claim Rejections Under 35 U.S.C. § 103**

Claim 11 has been rejected under 35 U.S.C. § 103 as being unpatentable over Ishikawa et al (U.S. Publication No. 2002/0,042,243) in view of Roberts et al. (U.S. Patent No. 6,171,181) Since the subject matter of Claim 11 has been incorporated into Claims 1 and 20, Applicant

addresses this issue as patentability of Claims 1 and 20, and respectfully submits that Claims 1 and 20 are allowable over the cited references, as discussed below.

Claims 1 and 20 recite, among other things “light transmittance in the light-transmitting region throughout the wavelength range of 400 to 700 nm is **50% or more** or a thickness of the light-transmitting region is 0.5 to 4 mm, and light transmittance in the light-transmitting region throughout the wavelength range of 600 to 700 nm is **80% or more**” As the Examiner asserts Ishikawa et al. teach that transmissivity is 22% or greater, (paragraph [0053]) and Roberts et al. teach that transmissivity is 20% or more (column 2, line 63), while the present specification teaches that the accuracy of detection of polishing endpoint of and accuracy of measurement of film thickness are reduced when the transmittance is lower than **50%**. (Page 8 Lines 20-25)

Thus, Ishikawa and Roberts recite the transmissivity so broadly while, the present specification teaches the critical threshold level of the transmittance to detect the polishing endpoint. In view of this fact, the cited references **fail to teach the specific feature** of the subject matter in Claims 1 and 20. Accordingly, **the cited reference would not match with the present claimed invention.**

Further, Claims 1 and 20 recites “An apparatus for chemical mechanical polishing of material to be polished in conjunction with the material to be polished” and “a length (D) in a diametrical direction is 1/4 to 1/2 relative to a diameter of a material to be polished” The cited references also fail to teach the instant features. Moreover, as explained above, the previously submitted Declaration established the criticality of this recited feature. Accordingly, the cited references would not match with the present claimed invention, even if combined, and will not lead to a prima facie showing of obviousness. Therefore Claims 1 and 20 are patentable over the cited references. Applicant respectfully requests withdrawal of the rejection.

### **CONCLUSION**

In the light of the applicant’s amendments to the claims and the following Remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

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No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

Please charge any additional fees, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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